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April 2, 2002

The Honorable James E. Rogan
Director, U.S. Patent and Trademark Office
Washington, D.C. 20231

Dear Director Rogan,

Attached is a letter I sent to you in December 2001.

I would like to have a brief meeting with you sometime in early May 2002, if possible. The subject of the meeting is the content of the December 21, 2001 letter.

Respectfully,

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December 21, 2001

VIA HAND DELIVERY

The Honorable James E. Rogan
Director, U.S. Patent and Trademark Office
Washington, D.C. 20231

Re: Patent Applications of BlackLight Power, Inc.

Dear Director Rogan:

I am writing to draw your attention to a matter involving the U.S. Patent and Trademark Office (PTO) that calls into question the professionalism, competence, and integrity of the PTO. As a former appointee (Reagan Administration, Assistant Secretary of Energy), technologist (nuclear engineering), and businessman (CEO and Chairman of several major US corporations over the past 15 years), I am heartened that you have finally taken up leadership of the PTO in the G.W. Bush Administration, and are in a position to reverse the sloth and abuses under the previous Administration. I have followed your public service career over the years, particularly your last term in the House, and am convinced that the President's choice to reform this critical agency could not have been more astute.

The matter that I invite your attention to involves the prosecution of a number of U.S. patent applications submitted by BlackLight Power, Inc., on whose Board of Directors I serve. My reasons for appealing to you in this matter are motivated not only by my fiduciary duty to protect BlackLight's best interests, but also by a sincere desire to assist you in avoiding unnecessary embarrassment this situation is sure to cause the Patent Office if left unresolved. We would be most pleased to personally meet with you and principles for the parties to see if together we can bring some closure to this matter in a way that is mutually acceptable to both sides.

Through your initial PTO briefing on important pending matters, you may be aware by now that five allowed applications relating to novel chemical compounds invented by BlackLight President and CEO, Dr. Randell L. Mills, were withdrawn from issue under extremely suspicious circumstances. That withdrawal led to a lawsuit that we filed in the D.C. District Court against Director Dickinson, which case was fully briefed and argued to the U.S. Court of Appeals for the Federal Circuit before a packed courtroom. The purpose of my letter is not to debate the legal issues in that case, as we are quite confident in our position based on the record presented to the Federal Circuit during oral argument. Rather, my aim is simply to make you aware of matters that PTO officials might have omitted from your initial briefing, including the prior administration's violation of well-established patent laws, rules, and procedures in prosecuting these and other BlackLight patent applications.

To be sure, BlackLight fully expected that, like any pioneering technology, its novel hydrogen chemistry would be carefully scrutinized by the Patent Office during the application process. Indeed, the two highly-qualified Examiners originally assigned to review BlackLight's applications, Wayne Langel and Stephen Kalafut, conducted a thorough examination, initially questioning the operability of the disclosed technology on several grounds. Upon critical review of BlackLight's supporting scientific evidence, however, the Examiners issued U.S. Patent No. 6.024,935 ("the '935 patent") drawn to an energy cell and allowed the five other chemical compound applications that were subsequently withdrawn from issue.

Examiners Langel and Kalafut displayed the utmost professionalism and courtesy in prosecuting BlackLight's applications and we certainly commend them for their actions. Unfortunately, the same cannot be said for others whose actions in withdrawing and subsequently prosecuting these and other cases have undermined the U.S. patent system to the detriment of all patent applicants. I offer the following examples for your consideration as possible topics for future discussion:

(1) **Undercutting the statutory presumption of validity under 35 U.S.C. § 282**

Underlying this 50-year-old statute is the premise of administrative regularity, which presumes that well-trained examiners with expertise in their respective fields will properly carry out their examination duties by issuing only valid patents. This presumption was, in fact, confirmed by the capable work Examiners Langel and Kalafut performed in examining and issuing BlackLight's '935 patent. Nonetheless, PTO Associate Solicitor Kevin Baer, for some explained reason, attacked BlackLight by denigrating the entire patent system, including its examining corps, by stating in open court:

> "[P]atent examiners do review [patent applications]. Unfortunately, patent examiners are swamped and sometimes things slip through."
>
> "[E]xaminers are under tremendous pressure to produce work, and if they're going to approve [an application]. they just approve it and kind of let it out the door."

Solicitor Baer's statements on behalf of the PTO should be alarming to just about everyone–with the possible exception of accused patent infringers—and most certainly do not reflect well on the agency. Part of our purpose in seeking a meeting is to make you aware of these and other outlandish statements and to give the PTO the opportunity to issue an appropriate public retraction.

(2) **Disparagement of U.S. patents in violation of MPEP § 1701**

According to this well-established PTO procedural guideline, "[p]ublic policy demands that every employee of the [Patent Office] refuse to express to any person any opinion as to the validity or invalidity of . . . any U.S. patent . . . ." With the exception of exclusions that do not

apply, "[t]he question of validity or invalidity is otherwise exclusively a matter to be determined by a court. Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the [Patent Office], including an employee of another Government agency, the answer to which might indicate that a particular patent should not have issued." The PTO clearly violated this admonition when it publicly disparaged the '935 patent on the record.

In yet another blatant violation of these PTO rules, Solicitor John Whealan responded to a reporter's inquiry by stating unequivocally for a soon-to-be published article that "the PTO issued BlackLight's '935 patent by mistake."

Once again, we wish to meet with you to discuss the PTO's retraction of these statements. More importantly, however, we seek an honest explanation why the PTO has singled out BlackLight for such disparate treatment and what can be done to put an end to it.

(3) PTO involvement with competitors of applicants in denying patent rights

Naturally concerned over who and what precipitated withdrawal of BlackLight's allowed applications from issue, we became suspicious that it might have been caused by competitors interfering with our valuable patent rights. Our suspicions heightened when we learned that Dr. Peter Zimmerman, former Chief Scientist for the State Department, had published an Abstract of an upcoming speech to the American Physical Society (APS), a BlackLight competitor, boasting that his Department and the Patent Office "have fought back with success" against BlackLight. In conversations with BlackLight's counsel, Dr. Zimmerman admitted that he received information concerning BlackLight's applications through e-mails from Dr. Robert Park, spokesman for the APS, who told him of a contact in the PTO referred to by Dr. Park as "Deep Throat."

If true, these actions would clearly violate the PTO's duty to maintain confidentiality of U.S. patent applications under 35 U.S.C. § 122, 18 U.S.C. § 2071, 37 C.F.R. § 1.14, and M.P.E.P. § 101, as well as raise other obvious concerns. We brought this information to the PTO's attention more than a year ago, but have yet to receive a response.

We would like to meet with you to discuss PTO investigations into this matter and the extent to which any breach of confidentiality may have occurred.

(4) Improperly creating new opposition procedures against the issuance of patents

Following withdrawal of BlackLight's applications from issue, counsel immediately began investigating the facts and circumstances surrounding that incident by questioning various PTO personnel. During that investigation, Director Esther Kepplinger admitted to counsel that she withdrew the applications in reaction to perceived heat—a "firestorm" as she put it—the Patent Office had received from an undisclosed outside source. Director Kepplinger further indicated that the withdrawal occurred only after the '935 patent had been brought to the

attention of Director Dickinson by Gregory Arahorian, another PTO outsider well known for his public attacks on issued U.S. patents.

These events, which, in effect, created an entirely new, non-regulatory procedure for opposing the issuance of patents, are disturbing to say the least. In light of these circumstances, we firmly believe that we are entitled to a full accounting of how, out of the thousands of patents the PTO issues on a weekly basis, our '935 patent happened to come to its attention, thus leading to the withdrawal of other allowed applications.

Unfortunately, the PTO has been less than forthcoming in dealing with this matter as succinctly expressed by Solicitor Baer to District Court Judge Emmet G. Sullivan in the following comments: "I would even say, Your Honor, you could imagine in our head any scenario of how we learned about it. A blimp flying over us. It doesn't matter, because what matters, Your Honor, is the decision [to withdraw] itself." Apparently Judge Sullivan was unimpressed by those comments, noting in footnote 10 of his opinion his being "troubled by several steps in the PTO's process" and advising the PTO to "examine its patent issuance process so that their normal operations are not compromised by such seemingly suspicious procedures."

That worthwhile goal can only be fully achieved by a complete accounting of the events in question, which we hope will be among the topics discussed at an upcoming meeting.

(5) <u>Withholding vital information concerning the examination process</u>

Following Judge Sullivan's decision upholding the PTO's withdrawal procedure, now on appeal, the PTO replaced the original Examiners Langel and Kalafut with a "Secret Committee" to reject all BlackLight applications. To adequately respond, BlackLight's counsel has sought to discover the identity of all Committee members, as well as any outside consultants or competitors, involved in the examination process and the nature of their involvement. To our amazement, the PTO has thwarted those efforts at every turn, as well as similar inquiries into this matter by five U.S. Senators.

Through our own discovery efforts, one of the Secret Committee members contributing to the prosecution was identified as Vasudevan Jagannathan. Despite Examiner Jagannathan's role in examining our applications, he initially refused to admit his involvement. Examiner Jagannathan later refused to even attend an interview scheduled with Dr. Mills, counsel, and myself to discuss the pending rejections in an attempt to reach an agreement over the patentability of the claimed inventions. Examiner Jagannathan ultimately appeared at the interview, but only after being ordered to do so by his immediate supervisor, to whom we complained. The interview, however, almost ended as soon as it began when counsel requested full identification of those persons responsible for examining our pending applications. In response, Examiner Jagannathan became quite hostile, threatening to adjourn the interview if we further pressed that line of inquiry, unjustifiably asserting that it was "not germane" to the prosecution.

We believe that such secret examination proceedings are not the way to conduct PTO business, especially in light of the suspicious circumstances surrounding withdrawal of BlackLight's applications. These proceedings do little to instill confidence in the examination process. Like any applicant. BlackLight is entitled to a fair hearing, which includes the right to directly confront those persons responsible for refusing us our patent grant. We hope that this issue will also be on the table for discussion should you be kind enough to grant us a meeting.

These are but a few of the more egregious examples of how the PTO has mishandled the examination process leading up to and following the withdrawal of BlackLight's applications from issue. Equally distressing is the substance of the Secret Committee's refusal to grant BlackLight's patents based on challenges to the operation of our disclosed hydrogen technology.

BlackLight has submitted an unprecedented amount of scientific evidence—costing tens of millions of dollars to produce—proving beyond question the operability of our technology. As former Assistant Secretary of Energy in the Reagan administration with a Ph.D. in Nuclear Engineering from M.I.T., I can personally attest to this fact. Anyone, however, with even a basic understanding of chemistry and, more importantly, an open mind willing to look seriously at our data, can confirm for themselves that Dr. Mills' novel hydrogen chemistry is producing truly astonishing results.

Incredibly, the Secret Committee has basically dismissed our scientific evidence or ignored it altogether on the basis that it supposedly violates "ideas" of modern science. For example, the scientific evidence we submitted includes spectroscopic data that is extraordinarily reliable in analyzing chemical compositions. Such data amounts to a "chemical fingerprint" that cannot be seriously disputed. Yet, Examiner Jagannathan dismissed that conclusive evidence out of hand as nothing more than "a bunch of squiggly lines."

Words can hardly express the extreme frustration—and forgive me for saying, deep resentment—we feel in having our pioneering technology treated in such a cavalier way. I could go on and on citing other examples of similar indignities suffered at the hands of the Secret Committee and, hopefully, we will be allowed to convey those details to you in person. Suffice it to say for now that the positions espoused by the Committee hardly satisfy the Constitutional directive that the patent system "promote the progress of science and the useful arts."

Please let me know at your earliest convenience if you share our desire for a meeting to discuss this matter. If you do, please further consider holding this meeting at our facilities in Cranbury, New Jersey so that you can witness first hand our working prototypes of Dr. Mills' energy cell and his assortment of novel hydride compounds exhibiting unusual properties.

I look forward to receiving your response and wish you well in your new undertaking.

Most sincerely,

Shelby T. Brewer